

**REMARKS**

This Amendment is in response to the Final Office Action mailed July 20, 2004.

Applicant acknowledges that, in paragraph 1 of the Office Action, claims 17 and 18 have been withdrawn from consideration as being directed to a non-elected invention.

Claim 1 has been amended to replace the term “content storage means” with “memory” to correct the antecedent basis. Claim 9 has been amended to correct a typographical error. In doing so, Applicant has not altered the scope of these claims.

Claims 1, 4-6, 9-16 and 19-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,397,079 to Shimoda et al. (Shimoda) in view of Applicant’s admitted prior art (AAPA). Applicant respectfully traverses these rejections.

Among the limitations of independent claim 1 which is neither taught nor suggested in the prior art of record is that the external server transmits “content data [which has been] converted into a data format that the radio terminal can reconstruct.” Independent claims 9, 12, and 19 recite a similar limitation. The claimed radio terminal, information processing system, external processing terminal, and method enhance the ability of a radio terminal to reconstruct content acquired from a content server through the Internet. The claimed radio terminal, information processing system, external processing terminal and method, including the advantages obtained thereby, are neither taught nor suggested in the prior art of record.

Shimoda is directed to a personal computer that can be interfaced with a cellular phone to facilitate voice communications (see Fig. 1.). In rejecting the claims over Shimoda, the Office Action cites to col. 1, line 55 to col. 3, line 35, virtually the entire Detailed Description of Shimoda. Shimoda discloses that the computer can receive commands from the user and invoke software routines that will formulate a transmission used to control the cellular phone. “For example, in response to a spoken command recognized by the computer, the transceiver may initiate a call.” See col. 2, lines 39-41.

Shimoda also discloses that the computer recognizes the user's speech in order to formulate telephone commands. See Fig. 3. Shimoda teaches or suggests that the advanced language translation features provided by the computer enables the user to "receive real-time translations of the spoken words generated by a caller or can send translated messages over the telephone to another person who speaks a different language." Col. 3, lines 20-24. Finally, Shimoda teaches that advanced encryption and authentication features can be provided by the computer and that a normal cellular telephone may not be able to implement these features. Shimoda, however, fails to teach or suggest acquiring content from the Internet and using the computer to convert that content into a data format that the radio terminal can reconstruct, as required by claims 1, 9, 12, and 19.

In order to establish a prima facie case of obviousness, the Examiner must meet basic criteria. As stated in MPEP § 2143, there first "must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. . . . [T]he prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination [must] be found in the prior art, and not based on applicant's disclosure." The Office Action does not meet this burden, because the combination of Shimoda with AAPA does not teach or suggest a computer that converts content into a data format that the radio terminal can reconstruct, and also because the Office Action does not provide a motivation to combine Shimoda with AAPA.

With respect to the combination of Shimoda and AAPA, paragraph 2 of the Office Action admits that Shimoda does not teach or suggest that the computer acquires content from the Internet. Shimoda discloses that a computer can be attached to a cell phone to provide speech recognition capability, real-time translations of spoken words, enhanced encryption or authentication, or other features "which are available in personal computers, for example" to facilitate voice communications. See col. 1, line 24. The AAPA discloses that the prior art radio terminal receives Internet content that it may not

be able to reconstruct. Thus, the combination of Shimoda with AAPA is a radio terminal that receives Internet content that it may not be able to reconstruct, coupled to a personal computer that provides enhanced cryptographic or voice communications functions. Applicant's invention is not a mere aggregation of these old parts. The references do not teach or suggest that the computer converts Internet content received by the radio terminal into content that the radio terminal can reconstruct. Shimoda's teaching that the language contained in an audio stream can be recognized and translated in real time does not provide a teaching of the conversion of Internet content into a format that a radio telephone can reconstruct. Likewise, the encryption/decryption of data is carried on independent of the device that may present such data. As the claimed limitation is missing from both reference teachings, a prima facie case of obviousness has not been made.

With respect to the deficiency regarding a motivation to combine, the AAPA discloses that acquiring content from the Internet by cellular phone is well known. As disclosed beginning at page 4, line 26 of AAPA, content delivered by a content server on the Internet is becoming increasingly more complex and "it is often difficult to reconstruct a state-of-the-art content after the elapse of years from the purchase time" of a radio terminal. But, this statement recognizing the problem does not provide one with skill in the art with the motivation to combine the AAPA with Shimoda. The Examiner has failed to provide a reasoned statement as to why one of ordinary skill in the art would have been motivated to combine the AAPA and Shimoda, and then modify the combination to include the claimed features. The fact that a recited feature is advantageous (e.g., "for utilizing advantages of the Internet network such as low cost, global information available in real-time") cannot be held against the Applicant and cannot substitute for the motivation that must be shown by the Examiner. This expression of purported motivation amounts to improper hindsight. If the Examiner intends to maintain that it would have been obvious to combine Shimoda with Applicant's admitted prior art, and further to modify the combination to arrive at the claimed invention, the Examiner is hereby respectfully requested to explain exactly what teachings in the prior art would have motivated one of ordinary skill to make the modification. The Applicant discovered the

advantageous claimed features, and the Examiner has offered no evidence whatsoever that such advantages were recognized in the prior art so as to provide for a possible motivation for its modification. As such, no prima facie case of obviousness has been set forth.

In addition, it should be noted that Shimoda is related to an entirely different field from the AAPA. Shimoda's personal computer provides functionality to facilitate voice communications over a cellular phone. Shimoda's personal computer is admitted in the Office Action as not related to acquiring data from the Internet. Since Shimoda does not concern the art of Internet content acquisition and reconstruction, it cannot be properly combined with AAPA. Applicant respectfully submits that this positive factor provides a further indicia of nonobviousness.

In view of the above, the combination of Shimoda with AAPA does not result in the claimed invention. In addition, one of skill in the art would have no desire or motivation to combine Shimoda's teachings of a personal computer interfaced to a cellular phone to facilitate cellular voice communications with those in the AAPA of a cellular phone lacking a computer and such interface, so that the phone's ability to reconstruct content acquired from the Internet is improved. Accordingly, Applicant respectfully submits that independent claims 1, 9, 12 and 19 patentably distinguish over the art of record.

Claims 4-6, 10-11, 13-16 and 20-24 depend either directly or indirectly from independent claims 1, 9, 12 or 19, and include all the limitations found therein. Each of these dependent claims include additional limitations which, in combination with the limitations of the claims from which they depend, are neither disclosed nor suggested in the prior art of record. Accordingly, these claims are likewise patentable.

In view of the foregoing, favorable consideration of the amendments to the claims, and allowance of the present application is respectfully and earnestly solicited.

Dated: September 17, 2004

Respectfully submitted,

By 

Robert G. Ginger

Registration No.: 45,755

DICKSTEIN SHAPIRO MORIN &  
OSHINSKY LLP

1177 Avenue of the Americas

41st Floor

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant